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CHICAGO IL 60661

**MAILED**

JUL 28 2010

**OFFICE OF PETITIONS**

In re Application of :  
Karaoguz, et al. :  
Application No. 10/606,565 : ON APPLICATION FOR  
Filed: June 26, 2003 : PATENT TERM ADJUSTMENT  
Attorney Docket No. 14169US02 :  
:

This is in response to the "APPLICATION FOR RECONSIDERATION OF THE DTERMINATION OF PATENT TERM ADJUSTMENT UNDER 35 USC 154(b) ACCOMPANYING THE NOTICE OF ALLOWANCE (37 CFR § 1.705)" filed June 25, 2010. Applicants request that the determination of patent term adjustment be corrected from nine hundred and four (904) days to one thousand, one hundred and forty-five (1,145) days. Applicants request this correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including –

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<sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on November 15, 2007.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is dismissed.

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **eight hundred and eight-nine (889) days**. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

Applicants assert the 2 day reduction to the patent term adjustment for the filing of a response on September 14, 2009, three months and two days after a non-final Office action was mailed on June 12, 2009, was improper. In summary, applicants state that the date that was three months after the mailing of the non-final Office action was Saturday, September 12, 2009, therefore, the filing of the response on Monday September 14, 2009, was timely.

Applicants' argument is not persuasive. Pursuant to 37 CFR 1.704(b), the period of adjustment of the term of the patent should be reduced by 2 days, the number of says in the period beginning on the day after the date that is three months after the date of mailing of the non-final Office action, September 13, 2009, and ending on the date the reply was filed September 14, 2009. The calculation of 2 days of application delay is based on the date of receipt of the response in the Office. The Office notes that 35 U.S.C. 154(b)(2)(C)(ii) does not require that a reply be filed in the Office within its three month grace period, but simply specifies that there is this three month period. Therefore, the "carry-over" provisions of 35 U.S.C. 21(b) does not apply to the three month periods in 35 U.S.C.

154(b)(2)(C)(ii). Accordingly, the reduction to the patent term adjustment of 2 days was warranted and will not be removed.

Further review of the application history reveals that an additional period of reduction of 15 days is warranted.

The record reveals that a final Office action was mailed August 20, 2007, to which applicants filed a response on November 15, 2007. On November 23, 2007, the Office mailed a Notice of Non-Compliant Amendment indicating that the response filed November 15, 2007, was not fully responsive to the Office action mailed August 20, 2007. Applicants filed an amendment on November 30, 2007. In this instance, the reduction to the patent term adjustment is calculated pursuant to 37 CFR 1.704(c)(7).

37 CFR 1.704(c)(7) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(7) Submission of a reply having an omission (§1.35(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date the reply or other paper correcting the omission was filed.

It is undisputed that the response filed November 15, 2007, contained an omission and that the response correcting the omission was not filed until November 30, 2007. Accordingly, pursuant to 37 CFR 1.704(c)(7), a period of reduction of fifteen (15) days will be entered as this period encompasses the period beginning on the day after the date the reply having an omission was filed, November 16, 2007, and ending on the date the reply correcting the omission was filed, November 30, 2007.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is eight hundred and eighty-nine (889) days

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.



Anthony Knight  
Director  
Office of Petitions

Enclosure: Copy of REVISED PALM screen

Day : Wednesday

Date: 7/28/2010

Time: 08:20:29

# PALM INTRANET

## PTA Calculations for Application: 10/606565

Application Filing Date:	06/26/2003	PTO Delay (PTO):	937
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	33
Post-Issue Petitions:	0	Total PTA (days):	889
PTO Delay Adjustment:	-15		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
134	07/28/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		15	
116	03/26/2010	MAIL NOTICE OF ALLOWANCE			
115	03/25/2010	ISSUE REVISION COMPLETED			
114	03/25/2010	DOCUMENT VERIFICATION			
113	03/25/2010	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
112	03/25/2010	NOTICE OF ALLOWABILITY			
111	03/22/2010	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
106	03/22/2010	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
105	03/22/2010	ELECTRONIC INFORMATION DISCLOSURE STATEMENT			
104	03/22/2010	REQUEST FOR CONTINUED EXAMINATION (RCE)			
103	03/23/2010	DISPOSAL FOR A RCE / CPA / R129			
102	03/22/2010	WORKFLOW - REQUEST FOR RCE - BEGIN			
101	03/02/2010	EXPORT TO INITIAL DATA CAPTURE			
100	02/24/2010	MAIL NOTICE OF ALLOWANCE			
99	02/24/2010	ISSUE REVISION COMPLETED			
98	02/24/2010	DOCUMENT VERIFICATION			
97	02/23/2010	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
96	02/23/2010	CASE DOCKETED TO EXAMINER IN GAU			
95	02/23/2010	NOTICE OF ALLOWABILITY			
91	02/16/2010	DATE FORWARDED TO EXAMINER			
90	02/11/2010	AMENDMENT AFTER FINAL REJECTION			
89	12/21/2009	MAIL FINAL REJECTION (PTOL - 326)			

88	12/17/2009	FINAL REJECTION				
85	10/07/2009	DATE FORWARDED TO EXAMINER				
84	09/14/2009	RESPONSE AFTER NON-FINAL ACTION		2	82	
83	10/07/2009	CASE DOCKETED TO EXAMINER IN GAU				
82	06/12/2009	MAIL NON-FINAL REJECTION				
81	06/11/2009	NON-FINAL REJECTION				
77	04/09/2009	DATE FORWARDED TO EXAMINER				
76	02/24/2009	RESPONSE AFTER NON-FINAL ACTION				
75	11/24/2008	MAIL NON-FINAL REJECTION				
74	11/21/2008	NON-FINAL REJECTION				
69	10/05/2008	CASE DOCKETED TO EXAMINER IN GAU				
68	08/11/2008	NEW OR ADDITIONAL DRAWING FILED				
67	08/19/2008	DATE FORWARDED TO EXAMINER				
66	08/11/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE				
65	08/19/2008	DATE FORWARDED TO EXAMINER				
64	08/11/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)				
63	08/19/2008	DISPOSAL FOR A RCE / CPA / R129				
62	08/11/2008	WORKFLOW - REQUEST FOR RCE - BEGIN				
61	06/09/2008	MAIL FINAL REJECTION (PTOL - 326)				
60	06/09/2008	FINAL REJECTION				
56	05/17/2008	DATE FORWARDED TO EXAMINER				
55	04/28/2008	RESPONSE AFTER NON-FINAL ACTION		31	52	
54	04/28/2008	REQUEST FOR EXTENSION OF TIME - GRANTED				
53	04/11/2008	CASE DOCKETED TO EXAMINER IN GAU				
52	12/28/2007	MAIL NON-FINAL REJECTION				
51	12/26/2007	NON-FINAL REJECTION				
50	12/11/2007	DATE FORWARDED TO EXAMINER				
49	11/30/2007	RESPONSE AFTER NON-FINAL ACTION				
48	11/30/2007	NEW OR ADDITIONAL DRAWING FILED				
47	11/23/2007	MAIL NOTICE OF INFORMAL OR NON- RESPONSIVE RCE AMENDMENT				
46	11/21/2007	NOTICE OF INFORMAL OR NON-RESPONSIVE RCE AMENDMENT.				
45	11/15/2007	NEW OR ADDITIONAL DRAWING FILED				
44	11/21/2007	DATE FORWARDED TO EXAMINER				
		AMENDMENT SUBMITTED/ENTERED WITH				

43	11/15/2007	FILING OF CPA/RCE			
42	11/21/2007	DATE FORWARDED TO EXAMINER			
41	11/15/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
40	11/21/2007	DISPOSAL FOR A RCE / CPA / R129			
39	11/15/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
38	10/04/2007	CASE DOCKETED TO EXAMINER IN GAU			
37	08/20/2007	MAIL FINAL REJECTION (PTOL - 326)			
36	08/17/2007	FINAL REJECTION			
35	04/16/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
34	04/16/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
33	06/21/2007	DATE FORWARDED TO EXAMINER			
32	06/20/2007	RESPONSE AFTER NON-FINAL ACTION			
31.7	04/16/2007	ELECTRONIC INFORMATION DISCLOSURE STATEMENT			
31	04/16/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30.7	04/16/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30	04/16/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
29	03/21/2007	MAIL NON-FINAL REJECTION	937		-1
28	03/19/2007	NON-FINAL REJECTION			
27	02/27/2007	CASE DOCKETED TO EXAMINER IN GAU			
26	11/16/2006	CASE DOCKETED TO EXAMINER IN GAU			
25	10/05/2006	CASE DOCKETED TO EXAMINER IN GAU			
24	03/21/2006	CASE DOCKETED TO EXAMINER IN GAU			
23	01/07/2005	MISCELLANEOUS INCOMING LETTER			
22	07/06/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
21	06/29/2004	CASE DOCKETED TO EXAMINER IN GAU			
20	04/30/2004	TRANSFER INQUIRY TO GAU			
19	02/27/2004	CASE DOCKETED TO EXAMINER IN GAU			
18	09/25/2003	APPLICATION RETURN FROM OIPE			
17	09/25/2003	APPLICATION RETURN TO OIPE			
16	09/25/2003	APPLICATION RETURN FROM OIPE			
15	09/25/2003	APPLICATION IS NOW COMPLETE			

14	09/24/2003	APPLICATION RETURN TO OIPE			
13	09/24/2003	APPLICATION RETURN FROM OIPE			
12	09/25/2003	APPLICATION IS NOW COMPLETE			
11	09/24/2003	APPLICATION RETURN TO OIPE			
10	09/24/2003	APPLICATION RETURN FROM OIPE			
9	09/24/2003	APPLICATION IS NOW COMPLETE			
8	09/24/2003	PRE-EXAM OFFICE ACTION WITHDRAWN			
7	09/24/2003	APPLICATION RETURN TO OIPE			
6	09/24/2003	APPLICATION DISPATCHED FROM OIPE			
5	09/24/2003	APPLICATION IS NOW COMPLETE			
4	09/10/2003	CASE CLASSIFIED BY OIPE			
3	09/10/2003	CLEARED BY OIPE CSR			
2	09/09/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	06/26/2003	INITIAL EXAM TEAM NN			

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#### EXPLANATION OF PTA CALCULATION

#### EXPLANATION OF PTE CALCULATION

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